

REMARKSClaim Status

Claims 1-48 were previously cancelled, and claims 49-68 are pending and were rejected over a single newly cited reference. The applicant appreciates withdrawal by the Examiner of all previous rejections and objections. Claims 51 and 61 are amended to enhance clarity, and Claim 68 is amended to correct an obvious typographical error. No new matter is added by these amendments. Entry of the amended claims and reconsideration in view of the following comments are respectfully requested.

Rejections under 35 U.S.C. 102

Claims 49-68 were rejected as allegedly being anticipated by Sucholeiki, U.S. Patent No. 5,835,329. The applicant traverses this rejection.

According to the Examiner, Sucholeiki "teaches a method comprising a device comprising electromagnets serving as sources are mounted on the base, so that the sources are essentially coplanar with a section through the active region, with the plane in question being parallel to the base (column 5, lines 15-25), for manipulating magnetic particles by attracting the particles to each of the active sources, or to a particular source that is activated (column 5, lines 35-45). The sources may be activated via suitable electronic circuits or computer-activated analog sources of currents such that alternation of the sets of sources of the gradients imposes magnetic field gradients in differing orientations (column 6, lines 35-45)."

No other rejections applicable to the two independent claims, claims 49 and 59, were presented.

To establish an anticipation rejection, the Examiner must show that a prior art reference discloses each and every limitation of the rejected claim. The Sucholeiki reference does not anticipate any of the pending claims for at least the following reasons.

Each of the two independent claims recites a method that includes features that were not shown to be present in Sucholeiki. The claims recite “an electromagnetic chip comprising ...microelectromagnetic units”. The cited reference was not shown to contain or disclose an “electromagnetic chip” or a device that comprises “microelectromagnetic units”, or any method for using such a device. No comparison to these claim limitations as they are described in the specification was provided in the analysis: the Examiner relied only on the presence of electromagnets and their orientation to describe the relevant features Sucholeiki device. This is insufficient description to disclose an ‘electromagnetic chip’ or a ‘microelectromagnetic unit’ under the applicable standard, which requires the Examiner to show that the reference discloses every limitation exactly as it is claimed. The claims must be read in view of the specification, and a ‘chip’ is discussed in the specification at page 19, which describes “a solid substrate on which one or more processes such as physical, chemical, biochemical, biological or biophysical processes can be carried out.” The Sucholeiki device does not appear to provide such a substrate, and does not disclose a method wherein “one or more processes such as physical, chemical, biochemical, biological or biophysical processes” on a substrate that is part of “an electromagnetic chip.”

In addition, each of the independent claims recites “contacting a sample comprising magnetic particles with said electromagnetic chip.” The reference does not disclose or suggest a method that involves contacting its device with a sample. The reference describes a device having magnets “arrayed about an active region”. (Col. 4, lines 2-5 describing Figure 1). The device is designed, according to the Brief Summary of the Invention, to manipulate magnetic particles “suspended in a solvent, the suspension contained in a suitable vessel, by the use of magnetic field gradients imposed externally to the vessel.” (Col. 3, lines 29-31). The magnetic particles in Sucholeiki are thus in suspension in a vessel, which can be placed in the ‘active region’ of the

device. And the magnetic fields employed in Sucholeiki's device are imposed from an external source, not one that is in contact with the sample. The abstract and the method descriptions in Sucholeiki both similarly describe a sample in "at least one vessel" or vial (abstract, and col. 3 lines 41-61).

Clearly, the suspension containing magnetic particles in Sucholeiki is in a container that can be used with the device and removed from the device, but is not part of the device: the sample in Sucholeiki is *not* permitted to contact the device itself. Therefore, the reference cannot anticipate the claimed invention.

Moreover, read as a whole, Sucholeiki does not even suggest the methods of the present claims, because its device is not designed to perform the claimed method. Modifying the device Sucholeiki describes in a way that could meet the 'contacting' limitation of the present claim would give up certain desirable features of that device, such as the ability to manipulate samples in a removable vessel and the ability to manipulate multiple samples in separate vessels. Having the sample in a vessel is an important aspect of the flexibility of the Sucholeiki device, because, "the use of arrays of vessels enables simultaneous manipulation of a large number of vials, test tubes or wells." (Col. 9, lines 66-67). Certain embodiments of the Sucholeki invention provide for "simultaneous agitation of magnetic particles in several suspensions, contained in several vessels..." (Col. 3, lines 41-43). Thus the Sucholeiki device does not anticipate the methods as claimed, or even suggest them. Accordingly, the anticipation rejection based on Sucholeiki should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **471842001411**. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

By 
Michael G. Smith

Registration No.: 44,422
MORRISON & FOERSTER LLP
12531 High Bluff Drive
Suite 100
San Diego, California 92130-2040
(858) 720-5113